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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/396,530 | 09/15/1999 | RANDALL A. ADDINGTON | 99-1002 | 7581 |

24253 7590 06/24/2002

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EXAMINER

PIERCE, WILLIAM M

| ART UNIT | PAPER NUMBER |
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3711

DATE MAILED: 06/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/396,530

Applicant(s)

ADDINGTON ET AL.

Examiner

William M Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4 and 14-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4,14-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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EXAMINER'S ANSWER TO REMAND OF 2/7/02 AND DECISION ON PETITION OF 3/19/02

Based on the Decision On Petition, Paper No. 25, it was granted that (1) the "examiner is directed to take appropriate action...to resolve the foregoing problems", to apparently (2) "invoke supervisory authority", (3) "to satisfy the Board's Concerns" and (4) "to consider reopening prosecution".

Respectively, the following actions have been taken;

1. Where the Examiner is directed to take appropriate action. Such is the purpose of this office action.
2. Examiner has sought the guidance and advice of the SPE of 3711. This office action is a result of such consultation.
3. The Board's Concerns, taken from the Remand filed 2/7/02, are "a number of irregularities" which are (a) treatment of claims 3 and 4 in the final rejection and (b) explanations of the 35 USC 112 rejection made. To satisfy the Board's Concerns, prosecution has been reopened to finally reject claims 3 and 4 and the dropping all issues under 35 USC 112.
4. In light of the above, prosecution has been reopened and the grounds of rejection stands as follows:
 - a. Rejections previously made in the final office actions and Examiner's Answers under 35 USC 112, to claims 13-40 for presenting new matter have not been sustained due to lack of support therefore by the Board of Appeals.
 - b. The drawings remain objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the steps of claims 14-30 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

In accordance with 37 CFR 1.81(c), where a drawing is not necessary for the understanding of the invention, but the subject matter sought to be patented admits of illustration. "The examiner should require such drawings in almost all such instances". The pending claims call for "forces" of lift, relationships between the finger, the finger shield and the ball, pressure, directions of forces and etc. All of which are not apparent from the drawings. In accordance with MPEP 608.02(e), the "examiner determines the completeness and consistency of drawings". Using claim 14 by way of example, the drawings fail to show "applying a force from said finger pad...", "producing a second force in a second direction", "receiving said second force in

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said second direction" and "contact area made between said finger pad of a bowler and said first surface..."

The drawings serve to allow examiner's and the public to quickly and accurately ascertain the claimed invention. The drawing failure to illustrate the positive steps of the claims make them incomplete.

c. Claims 3, 4 and 14-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Marinese et al.

As to claim 14, paragraphs a-c are shown in Marinese by his finger pad shield 1 in contact with a finger pad of a bowler's finger at 7b. The finger pad 1 shield has a first and second surface at 7b and 3 respectively as shown in his fig. 1. Fig. 1 shows inserting the finger pad into a finger hole of a bowling ball. The apparatus of Marinese transmits the forces applied by the bowler's fingers to the finger pad and then to the bowling ball to control the release and the lift placed on the ball as called for in steps d-f. While these "applying a first force", "producing a second force" and how these forces interact with the finger pad and the bowling ball are not specifically disclosed, it is noted that, in method claims, the prior art anticipates a claimed invention if the device carries out the method during normal operation. (See MPEP 2112.02). Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. While the discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using. In re Huck, 114 USPQ 161, 163 (CCPA 1957). Such is not the case here since the apparatus of Marinese and the instant invention are being used to transmit forces from a bowler's hand to a bowling ball which is old and well known.

Steps d-f of claim 14 are old to the use of all finger supports. Such a position of the Examiner that these steps are old is admitted by Appellant at the bottom of pg. 13 through the bottom of pg. 15 of his Brief. Clearly, Appellant is merely reciting the known forces that interact between the finger, protector and the ball during the delivery of a bowling ball.

As to claim 15 a bowler is considered to always exert a "maximum natural force" when delivering a ball. The forces recited to be involved are admittedly well known in the art at the bottom of pg. 16 of the Brief.

As to claim 3, Marinese states in col. 2, lns. 47-49, that the material is "substantially rigid material such as a suitable plastic or an appropriate metal" which is considered to be "made of rigidly deflectable material" capable of "holding said finger pad shield stable" and "transferring a force". As such the limitations of claim 3 are considered met. Further such limitation are present in the prior art as admitted in the middle of pg. 17 of the Brief.

Distributing the force over the widest area of the contact area as recited in claim 16 is known in Marinese and old in the art. Top of pg. 19 of the Brief admits that nothing new in the art is being claimed.

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The step of "reducing said pressure substantially within said contact area" in claim 17 is rudimentary and inherent to finger supports such as Marinese and admitted as known in the prior art at the top of pg. 20 of the Brief.

Distributing the second force substantially uniform as called for in claim 18 is inherent in Marinese and old in the prior art as admitted on the top of pg. 21 of Brief.

Reducing the contact pressure as in claim 19 is inherent in Marinese and old in the prior art as admitted on the top of pg. 22.

Claim 20 is inherent in Marinese and old in the prior art as admitted on the top of pg. 23.

Claims 21-30 are rejected for the reasons set forth above with respect to claims 3 and 14-20 above.

On pg. 10 of Appellant's Reply he states that "lift" is not mentioned anywhere in Marinese. While this is true, the term lift as it pertains to the delivery of a bowling ball is old and well known in the art. Appellant agrees with the Examiners position and admits that such is old at the bottom of pg. 13 of his Brief. A reference is to be considered not only for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill in the art. (In re DeLisle, 56 CCPA 1319, 406 F.2d 1386, 867 OG 722, 160 USPQ 806). Further in determining the question of obviousness, it is not only the express teachings of the references which are to be considered but what they would collectively have suggested to one of ordinary skill in the art. (See In re Simon, 59 CCPA 1140, 461 F.2d 1387). In the instant case, one skilled in the art of bowling and viewing Marinese would have been familiar with the delivery of a bowling ball down the alley and the inherent forces involved. This is admitted by the Appellant in his Brief as not new. As such, the instant rejection under 102 and inherency is considered well founded. Pgs. 11-14 of Appellants Reply are noted without additional comment since they merely restate Appellants position set forth in the Brief. Claims 3 and 4 are rejected in paragraph 5 of the First Office Action filed 3/20/00.

With respect to the examiner's position on inherency. Once such a rejection is made by the Examiner, the burden was shifted to Appellant. Note MPEP 2183;

If the examiner finds that a prior art element performs the function specified in the claim, and is not excluded by any explicit definition provided in the specification for an equivalent, the examiner should infer from that finding that the prior art element is an equivalent, and should then conclude that the claimed limitation is anticipated by the prior art element. The burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure, material or acts disclosed in the application. In re Mulder, 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983). No further analysis of equivalents is required of the examiner until applicant disagrees with the examiner's conclusion, and provides reasons why the prior art element should not be considered an equivalent. See also, In re Walter, 618 F.2d 758, 768, 205 USPQ 397,

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407 - 08 (C.C.P.A. 1980) (a case treating 35 U.S.C. 112, sixth paragraph, in the context of a determination of statutory subject matter and noting "If the functionally - defined disclosed means and their equivalents are so broad that they encompass any and every means for performing the recited functions . . . the burden must be placed on the applicant to demonstrate that the claims are truly drawn to specific apparatus distinct from other apparatus capable of performing the identical functions"); In re Swinehart , 439 F.2d 210, 212 - 13, 169 USPQ 226, 229 (C.C.P.A. 1971) (a case in which the CCPA treated as improper a rejection under 35 U.S.C. 112, second paragraph, of functional language, but noted that "where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristics relied on"); and In re Fitzgerald , 619 F.2d 67, 205 USPQ 594 (CCPA 1980) (a case indicating that the burden of proof can be shifted to the applicant to show that the subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103).

Appellant has not shown that prior art element does not perform the functions specified in the claims. While he did make attempts to do so with the Addington Declaration, such was insufficient since it was subjective in its interpretation and failed to set forth facts. In addition, on pgs. 13-23 of his Brief specifically sets forth that these functions in the claims are old and well known in the art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (703) 308-3551.


Any inquiry not concerning the merits of the case such as **missing papers, copies, status or information** should be directed to Tech,Center 3700 Customer Service Center at (703) 306-5648 where the fax number is (703) 308-7957 and the email is Customerservice3700@uspto.gov.

For **official fax** communications to be officially entered in the application the fax number is (703) 305-3579.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.



**WILLIAM M. PIERCE
PRIMARY EXAMINER**